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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10002214-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sarah M. Brandenberger et al.

Confirmation No.: 9353

Application No.: 09/776,058

Examiner: G. V. Selby

Filing Date: February 2, 2001

Group Art Unit: 26222

Title: A SYSTEM AND METHOD FOR LENS FILTER EMULATION IN DIGITAL PHOTOGRAPHY

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on October 19, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

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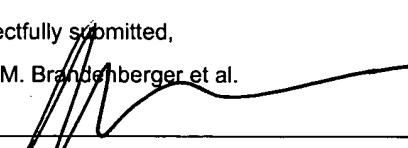
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Respectfully submitted,
Sarah M. Brandenberger et al.

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Docket No.: 10002214-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sarah M. Brandenberger, et al.

Confirmation No.: 9353

Application No.: 09/776,058

Group Art Unit: 2622

Filed: 02/02/2001

Examiner: Selby, Gevell V.

For: A SYSTEM AND METHOD FOR LENS
FILTER EMULATION IN DIGITAL
PHOTOGRAPHY

APPELLANT'S REPLY BRIEF (37 C.F.R. § 41.41)

Attention: Board of Patent Appeals and Interferences
Commissioner for Patents
PO Box 1450
Washington, DC 20231

Dear Sir:

This Reply Brief, filed pursuant to 37. C.F.R. § 41.41, is in response to the Examiner's Response, mailed in this case on October 19, 2006. Should the Primary Examiner not find the comments contained herein persuasive, acknowledgement of receipt and entry of this Reply Brief is requested.

The fees required under 37 C.F.R. § 1.17(c) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL REPLY BRIEF.

I. Status of Claims

A. Total Number of Claims in Application

There are 24 claims pending in this application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-24
4. Claims allowed: None
5. Claims rejected: 1-20
6. Claims objected to: 21-24

C. Claims On Appeal

The claims on appeal are claims 1-20

II. Grounds of Rejection to be Reviewed On Appeal

A. Whether the rejection of claims 1-2, 4-5, and 7-14 under 35 U.S.C. § 103(a) over Anderson in view of Kim is proper.

B. Whether the rejection of claims 15-20 under 35 U.S.C. § 103(a) over Kim in view of Anderson is proper.

C. Whether the rejection of claim 3 under 35 U.S.C. § 103(a) over Anderson in view of Kim and Shiomi is proper.

D. Whether the rejection of claim 6 under 35 U.S.C. § 103(a) over Anderson in view of Kim and Safai et al. is proper.

III. Argument

A. **Claims 1-2, 4-5 and 7-14**

Claims 1-2, 4-5 and 7-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, United States Patent Number 6683649, in view of Kim, United States Patent Number 6137532.

It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant respectfully asserts that not all criteria have been met.

1. Lack of Motivation

It is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.C. 349 (COCA 1959). Appellant's amendment of 1/5/2006, asserted that there is no motivation to combine Anderson with Kim, as the combination would change a principle of operation of the prior art. In response, the Final Office Action of 3/20/2006 alleges that the color and burst signals of Kim are not incompatible with Anderson. Further, in the Examiner's Answer mailed on 10/19/2006, the Examiner opines his proposed modification "would not change the principle operation of Anderson, because both references perform digital processing on the image data." See pg. 12. Appellant respectfully disagrees.

As an initial matter, Appellant notes that Kim's color and burst signals are analog signals, whereas Anderson teaches a camcorder that uses digital signals. Thus, in order to modify Anderson to be combined with Kim, Anderson must be modified to use analog signals. Appellee

further points out that Kim teaches both analog and digital data. However, Appellant notes that the values of digital data taught by Kim correspond to the amplitude of an analog color signal, wherein the phase difference between the analog color signal and a burst signal determines the hue. Anderson teaches using digital signals, wherein the values of digital data taught by Anderson correspond to the hue without the use of a phase difference between analog signals. As such, in order to combine Anderson with Kim, the principle of operation of Anderson must be changed to use a phase difference between the analog color signal and a burst signal to determine a hue instead of a digital signal. Therefore, Appellant respectfully asserts the teachings of the references do not render the claims *prima facie* obvious and requests that all rejections based on Anderson in view of Kim be reversed.

It is also well settled that the teaching or suggestion to make the claimed combination must be found in the prior art, not in Appellant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellee's stated motivation, on page 2 of the Final Office Action, of reducing the space needed to provide filtering options may be gleaned from the abstract, page 3 lines 3-12, and page 4 lines 11-16 of Appellant's specification. However, Appellant can find no aspect of Anderson or Kim providing such motivation. As such, the teaching or suggestion to make the claimed combination was not found in the prior art. Thus, there exists no suggestion or motivation found in the prior art to modify the reference or to combine reference teachings, such that the stated motivation is from Appellant's disclosure.

In the Examiner's Answer mailed on 10/19/2006, the Examiner opines that the proposed modification "would not change the principle operation of Anderson, because both references perform digital processing on the image data." *See* pg. 12. Appellant respectfully disagrees with the Examiner's rationale. As discussed above, Anderson and Kim disclose the notion of "digital" and "processing." Nevertheless, modifying Anderson as the Examiner suggests would require that Anderson be changed to use a phase difference between the analog color signal and a burst signal to determine a hue instead of a digital signal. This would change a principle operation of Anderson, and would require substantial physical reconfiguration. Therefore, Appellant

respectfully asserts that the teachings of the references do not render the claims *prima facie* obvious and requests that all rejections based on Anderson in view of Kim be reversed.

2. Lack of Limitations, Claims 1-2, 4-5, and 7

Claim 1 recites a processor configured to process said pixel data in response to said selected image filter to provide filtered image data. In the Examiner's Answer, the Examiner acknowledges that Anderson does not teach or suggest this limitation. *See* Examiner's Answer, pgs. 3-4. Instead, the Examiner relies upon Kim, at various citations, to satisfy this limitation. In doing so, the Examiner opines that "[Kim's] image data is processed by the controller or processor by being replaced with the filtering effect color data when filtering is selected." *Id.* at pg. 4. Appellant respectfully disagrees. Appellant points out that Kim only teaches either providing original data (C1) or terminating the original data and generating new data (C2) (*see* Kim, column 3, line 61 to column 4, line 7), yet does not provide filtered image data. As such, Kim does not teach or suggest provide filtered image data, as set forth in the claim. Thus, Anderson in view of Kim does not teach or suggest all the limitations of claim 1. Therefore, Appellant respectfully asserts that claim 1 is patentable over Anderson in view of Kim and requests that the rejection be reversed.

Claims 2, 4-5, and 7 depend from and inherit all the limitations of claim 1. As discussed above, claim 1 contains features and limitations that are neither taught nor suggested by Anderson in view of Kim. Thus, claims 2, 4-5, and 7, depending from claim 1, are nonobvious. Therefore, Appellant respectfully asserts that claims 2, 4-5, and 7 are patentable over Anderson in view of Kim and requests that the rejection be reversed.

3. Lack of Limitations, Claims 8-14

Claim 8 requires a processor configured to perform an adjustment of the properties of said digital visual recording device to include selected ones of said filter effects. In support of the rejection, the Examiner states that Anderson does not teach or suggest "editing and displaying an image using digital color filtering." *See* Examiner's Answer, pg. 6. As an initial matter,

Appellant respectfully notes editing and displaying an image using digital color filtering is not a recited limitation. The Examiner then reads teachings of Kim onto limitations of claim 1, *see id* at pg. 6, yet not those of claim 8. Further, Appellant can find no aspect of Kim that addresses performing an adjustment of the properties said digital visual recording device to include selected ones of said filter effects. As such, Anderson in view of Kim does not teach or suggest all the limitations of claim 8. Thus, the prior art references when combined do not teach or suggest all the claim limitations. Therefore, Appellant respectfully asserts that claim 8 is patentable over Anderson in view of Kim and requests that the rejection be reversed.

Claims 9-14 each depend from and inherit all the limitations of claim 8. As discussed above, claim 8 contains features and limitations not taught or suggested by Anderson in view of Kim. Thus, claims 9-14, depending from claim 8, are nonobvious. Therefore, Appellant respectfully asserts that claims 9-14 are patentable over Anderson in view of Kim and requests the rejection be reversed.

B. Claims 15-20

Claims 15-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kim in view of Anderson. It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant respectfully asserts that not all criteria have been met.

1. Lack of Motivation

It is well settled that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Anderson teaches a camcorder that uses digital signals with

the hue stored as a magnitude of the digital data (e.g., see column 5, lines 49-52, CCIR streaming video, which has three signals: one 13.5MB/sec Luminance (gray scale) and two 6.75 MB/sec chrominance (color)), whereas Kim teaches the use of analog color and burst signals that require a phase difference to determine the hue (column 3, lines 16-20). Thus in order to modify Kim to be combined with Anderson, Kim must be modified to use the digital signals of Anderson. Appellee further pointed out that Kim teaches both analog and digital data. However, Appellant notes that the values of digital data taught by Kim correspond to the amplitude of an analog color signal, wherein the phase difference between the analog color signal and a burst signal determines the hue. Anderson teaches using digital signals, wherein the values of digital data taught by Anderson correspond to the hue without the use of a phase difference between analog signals. As such, in order to combine Kim with Anderson, a principle of operation of Kim must be changed to use digital values to determine a hue instead of a phase difference between analog signals to determine a hue. Thus, the proposed combination of the prior art would change the principle of operation of the prior art invention. Therefore, Appellant respectfully asserts that the teachings of the references are not sufficient to render claim 15 *prima facie* obvious and requests that all rejections based on Kim in view of Anderson be reversed.

It is also well settled that the teaching or suggestion to make the claimed combination must be found in the prior art, not in Appellant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellee's stated motivation, on page 2 of the Final Office Action, of reducing the space needed to provide filtering options may be gleaned from the abstract, page 3 lines 3-12, and page 4 lines 11-16 of Appellant's specification. However, Appellant can find no aspect of Kim or Anderson providing such motivation. As such, the teaching or suggestion to make the claimed combination was not found in the prior art. Thus, there exists no suggestion or motivation found in the prior art to modify the reference or to combine reference teachings, such that the stated motivation is from Appellant's disclosure. Therefore, Appellant respectfully asserts that the teachings of the references do not render the claims *prima facie* obvious and requests that all rejections based on Kim in view of Anderson be reversed.

2. Lack of Limitations

Claim 15 recites selecting a first filter and selecting a second filter. Anderson is not relied upon and does not teach or suggest these limitations. Appellant's previous arguments noted that Kim teaches selecting a desired color instead of a first filter and a second filter. In response, Appellee identifies the color selection key (222) as allowing the user to select a desired color, but then identifies a first filter as a B-Y color filtering effect and a second filter as an R-Y color filtering effect. *See* Examiner Answer, pg. 15. Appellant notes that both the B-Y color filtering effect and the R-Y color filtering effect are based on the single selection of a desired color. As such, Kim in view of Anderson does not meet selecting a first filter and selecting a second filter. Thus, Kim in view of Anderson, when combined, does not teach or suggest all claim limitations. Therefore, Appellant respectfully asserts that claim 15 is patentable over the cited prior art and requests the rejection be reversed.

Claims 16-20 each depend from and inherit all the limitations of claim 15. As discussed above, claim 15 contains features and limitations that are not found in Kim in view of Anderson. As such, Kim in view of Anderson does not teach or suggest all the limitations of claim 16-20. Therefore, Appellant respectfully asserts that claims 16-20 are patentable over Kim in view of Anderson and requests that the rejection be reversed.

C. Claim 3

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Kim and Shiomi, United States Patent Number 6650361. It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant respectfully asserts that not all criteria have been met.

It is well settled that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellee, at page 11 of the Examiner's Answer, alleges that the combination of the teachings of Anderson and Kim when combined with the teachings of Shiomi meet the limitations of claim 3. However, as discussed above, there is insufficient motivation to combine the teachings of Anderson and Kim. The motivation used to add the teachings of Shiomi to the combination does not cure the deficiency of the motivation used to combine the teachings of Anderson and Kim. Therefore, Appellant respectfully asserts that the combination of the teachings of Anderson, Kim, and Shiomi is improper and requests that the rejection be reversed.

It is also well settled that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claim 3 depends from and inherits all the limitations of claim 1. As discussed above, claim 1 contains features and limitations that are not found in Anderson in view of Kim. Shiomi is not relied upon and does not teach or suggest such limitations. As such, the combination of the teachings of Anderson in view of Kim and Shiomi does not teach or suggest all the limitations of claim 3. Therefore, Appellant respectfully asserts that claim 3 is patentable over Anderson in view of Kim and Shiomi and requests that the rejection be reversed.

D. Claim 6

Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson in view of Kim and Safai et al., United States Patent Number 6167469 (hereinafter Safai). It is well settled that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellant respectfully asserts that not all criteria have been met.

It is well settled that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Appellee, at page 11 of the Examiner's Answer, alleges that the combination of the teachings of Anderson and Kim when combined with the teachings of Safai meet the limitations of claim 6. However, as discussed above, there is insufficient motivation to combine the teachings of Anderson and Kim. The motivation used to add the teachings of Safai to the combination does not cure the deficiency of the motivation used to combine the teachings of Anderson and Kim. Therefore, Appellant respectfully asserts that the combination of the teachings of Anderson, Kim, and Safai is improper and requests that the rejection be reversed.

It is also well settled that if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claim 6 depends from and inherits all the limitations of claim 1. As discussed above, claim 1 contains features and limitations that are not found in Anderson in view of Kim. Safai is not relied upon and does not teach or suggest such limitations. As such, the combination of the teachings of Anderson in view of Kim and Safai does not teach or suggest all the limitations of claim 6. Therefore, Appellant respectfully asserts that claim 6 is patentable over Anderson in view of Kim and Safai and requests that the rejection be reversed.

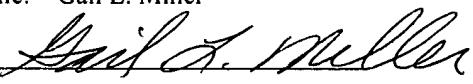
IV. Conclusion

Once again, Appellant thanks the Board for their time and consideration. At least for the reasons discussed above, reversal of the grounds of rejection is respectfully requested.

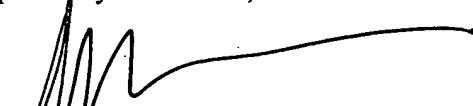
I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV 568240674U in an envelope addressed to: M/S Amendment, Commissioner for Patents, Alexandria, VA 22313.

Date of Deposit: December 15, 2006

Typed Name: Gail L. Miller

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Respectfully submitted,

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